



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,031	07/25/2000	Ikuko Umezawa	2927-0114P	6752

7590 08/28/2002

Birch Stewart Kolasch & Birch LLP  
P O Box 747  
Falls Church, VA 22040-0747

EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
----------	--------------

1772

8

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

<b>Advisory Action</b>	Applicati n No. 09/625,031	Applicant(s) UMEZAWA, IKUKO	
	Examiner Marc A Patterson	Art Unit 1772	

-The MAILING DATE of this c mmunication appears on th cover sheet with the correspondence address --

THE REPLY FILED 16 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. ☒ The proposed amendment(s) will not be entered because:
  - (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- 3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
- 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
- 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-5.

Claim(s) withdrawn from consideration: none.

- 8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
- 9. ☐ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.
- 10. ☒ Other: See attached.

**ADVISORY ACTION**

*Applicant's arguments filed August 16, 2002 have been fully considered but have not been found to be persuasive.*

1. Applicant argues, on page 6 of Paper No. 7, that amended Claims 1 – 5 overcome the prior art of record. However, the limitations ‘said outsole including a heel portion and a forefoot portion’ and ‘a plurality of spikes located on the heel portion and the forefoot portion of said outsole, each of said plurality of spikes including a disk shaped portion and a plurality of pins’ are not discussed in the original specification; the phrases ‘heel portion’ and ‘forefoot portion’ do not appear in the specification, in fact, and therefore have not been defined. The amended claims therefore constitute new matter, and the amendments will therefore not be entered.

Applicant also argues, on page 6, that the rejection is improper because column 1, lines 12 – 22 of Kataoka et al. is insufficient to indicate that the spike disclosed by Kataoka et al. is made of synthetic resin. Kataoka et al disclose a spike – attaching portion which is made of synthetic resin, Applicant argues, but does not disclose a spike which is made of synthetic resin. However, the spike – attaching portion clearly is a portion of the spike.

Applicant also argues, on page 7, that the combination of Kataoka et al with Wideman et al is improper because Kataoka et al disclose a shoe for use in track and field events; it is therefore likely, Applicant speculates, that a resin which is used in Kataoka et al would be a harder material than the rubber materials which are taught by Wideman et al. However, as stated on page 2 of the previous Action, Kataoka et al disclose the use of synthetic resin, which certainly does not exclude the use of any rubber. The term ‘hard plate’ is used in Kataoka to

Art Unit: 1772

describe the body of insole, but this is a relative term which still does not exclude the use of the rubber compositions which Wideman et al. teach for the making of insoles.

Applicant also argues, on page 9, that the hardness which is taught by Wideman et al is outside of the claimed range. However, as stated on page 2 of the previous Action, Wideman et al. teach a hardness of 50.5, as measured by sclerometer (Shore hardness; column 10, lines 25 – 48). Therefore, the claimed range of hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the hardness, since the hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Wideman et al *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant also argues, on page 9, that the rejection is improper because Norton does not teach that it is known for the spikes of a shoe sole to have a lower hardness than the remainder of the shoe sole. Although the cleats taught by Norton have a lower hardness than the remainder of the shoe sole, Applicant argues, the cleats are not the same as spikes. However, Norton also teaches that spikes and cleats are equivalent as traction elements of a shoe sole (column 1, lines 31 – 55).

Applicant also argues, on page 10, that the previous Action provides no motivation for varying the hardness which is taught by Wideman et al. However, as stated above, Wideman et al. teach a hardness of 50.5, as measured by sclerometer (Shore hardness; column 10, lines 25 – 48). Therefore, the claimed range of hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the

Art Unit: 1772

product. It therefore would be obvious for one of ordinary skill in the art to vary the hardness, since the hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Wideman et al *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant also argues, on page 11, that the rejection is improper because Norton does not teach a hardness difference of from 5 – 80, as measured by JIS – C. However, as stated on page 2 of the previous Action, Norton teaches a hardness difference of 10, as measured by sclerometer (Shore hardness; column 4, lines 23 – 31). Therefore, the hardness difference would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the hardness difference, since the hardness difference would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Norton. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold

Art Unit: 1772

Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

*Marc Patterson*  
Art Unit 1772

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

*8/27/02*